



54
UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/138,459	08/21/1998	SHOLOM S. ROSEN	0225-4161US1	4108

7590 06/16/2003
MORGAN & FINNEGAN
345 PARK AVENUE
NEW YORK, NY 10154

EXAMINER

SONG, HOSUK

ART UNIT	PAPER NUMBER
----------	--------------

2131

DATE MAILED: 06/16/2003 24

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/138,459

Applicant(s)

ROSEN

Examiner

HOSUK SONG

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 7, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-15 and 17-19 is/are pending in the application.
- 4a) Of the above, claim(s) 12-15, 17, and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 2131

DETAILED ACTION

1. In response to the Requirement for Restriction(paper #23), Applicant elects without traverse to prosecute claim 19.

Claim Rejections - 35 USC § 103

- 2 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 3 Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer (US 5,422,953) in view of Denno et al.(US 5,493,613).

Claim 19: Fischer disclose a tamper proof electronic transaction device comprising an external interface in (col.3,lines 31-38 and fig.1). Fischer disclose an electronic processor in communication with external interface in (col.3,lines 25-30). Fischer disclose a memory that stores a unique digital certificate associated with transaction device where digital certificate includes unique identifier, a public key, and digital signature in (col.5,lines 59-68;col.6,lines 8-21; col.8,lines 17-21). Fischer disclose a key generator that generates a public and private key pair,wherein public key is included within digital certificate in (col.8,lines 43-46;col.9,lines 63-67). Fischer disclose a random number generator in (fig.1#10). Fischer does not specifically disclose the key generator includes a random number generator. Denno patent disclose tamper resistant



Art Unit: 2131

module in which key generator includes a random number generator in (col.7,lines 52-54). It would have been obvious to person of ordinary skill in the art at the time invention was made to include key random generator disclosed in Denno with tamper resistant device taught in Fischer because randomness allows unpredictable outcome and it is computationally infeasible to predict what the next random bit will be, given complete knowledge of the algorithm or hardware generating the key and all of the previous bits in the stream thus preventing against random,continuous attack by the hackers. Fischer disclose digital certificate includes a unique device identifier and digital signature is provided by a security server which creates digital certificate in (col.5,lines 62-68;col.7,lines 30-42).

4. Any inquiry concerning this communication should be directed to Hosuk Song whose telephone number is (703)305-0042. The examiner can normally be reached on Tuesday through Friday from 6:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gail Hayes can be reached at (703)305-9711.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist, whose telephone number is (703)305-3900.



GAIL HAYES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100